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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,152	01/04/2007	Joacim Elmen	22460-0041001 / 1019US	1052
26161	7590	03/03/2011		
FISH & RICHARDSON P.C. (BO)			EXAMINER	
P.O. BOX 1022			VIVLEMORE, TRACY ANN	
MINNEAPOLIS, MN 55440-1022				
			ART UNIT	PAPER NUMBER
			1635	
			NOTIFICATION DATE	DELIVERY MODE
			03/03/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/550,152

Applicant(s)

ELMEN ET AL.

Examiner

Tracy Vivlemore

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 67-97 and 102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 67-97 and 102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Any rejection or objection not reiterated in this Action is withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 67-97 and 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Crooke (US 6,107,094) and Orum et al. (US 2002/0068709).

Crooke teaches at column 12 oligomeric compounds that bind to a target RNA strand and are substrates for dsRNase enzymes. The oligomeric compounds include oligoribonucleotides and other oligomeric compounds having a linear sequence of linked ribonucleoside subunits incorporated therein. The oligoribonucleotides are assembled from a plurality of nucleoside subunits. In certain preferred embodiments at least one of the nucleoside subunits bears a substituent group that increases the binding affinity of the oligoribonucleotide for a complementary strand of nucleic acid. In certain embodiments of the invention, specific nucleoside subunits or internucleoside linkages are functionalized or selected to increase the nuclease resistance of the oligoribonucleotide or oligoribonucleoside. At column 14 Crooke teaches that the oligomeric compounds of the invention are preferably 15-25 nucleotides in length. One embodiment of oligomeric compounds specifically taught by Crooke in examples 24 and 27a are artificial substrates for dsRNase enzymes. These substrates comprise sense and antisense strands wherein one or both strands are chemically modified. Crooke exemplifies embodiments where the artificial substrate is 17 and 20 nucleotides in length. Crooke does not teach LNAs as a modified nucleoside subunit.

Orum et al. teach that to be useful an oligonucleotide must have properties such as good resistance to extra- and intracellular nucleases as well as high affinity and specificity for the target. Orum et al. further teach that DNA compounds referred to as Locked Nucleic Acids, which have bicyclic sugars, provide extremely stable duplexes with a target nucleic acid.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce the artificial nuclease substrates of Crooke with one or more LNA monomers as taught by Orum et al. Based on the disclosure explicit teachings of Crooke of artificial substrates that contain modified nucleotides and his teaching that modifications are intended to increase nuclease resistance and/or binding affinity of the oligoribonucleotide for a complementary strand of nucleic acid the person of ordinary skill in the art would have reason to make modified substrates and based on the teachings of Orum et al. that inclusion of LNA monomers provide nuclease resistance and extremely stable duplexes the person of ordinary skill would be motivated to make the modified substrate with one or more LNA monomers. Based on the broad disclosure of Crooke one of ordinary skill would recognize the inclusion of multiple LNA moieties and the placement of these moieties to be a matter of design choice.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Vivlemore whose telephone number is 571-272-2914. The examiner can normally be reached on Mon-Fri 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Calamita, can be reached on 571-272-2876. The central FAX Number is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tracy Vivlemore
Primary Examiner
Art Unit 1635

/Tracy Vivlemore/
Primary Examiner, Art Unit 1635